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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Mario Bogdan; David J. Lima; Keith J. Hocker; Tony J. Liliros
Serial No.: 09/940,261
Filed: August 27, 2001
Title: HELICAL DRIVE INSERTION AND EJECTION

Examiner: Rick Kiltae Chang
Group Art Unit: 3729
Docket No.: 1014-011US01

CERTIFICATE UNDER 37 CFR 1.8: I hereby certify that this correspondence is being deposited with the United States Post Service, as First Class Mail, in an envelope addressed to: Mail Stop: Petitions, Commissioner for Patents, Alexandria, VA 22313-1450 on January 22, 2004.

By: *Beth M. Lindblom*
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PETITION FROM REQUIREMENT FOR RESTRICTION UNDER 37 C.F.R. 1.144

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OFFICE OF PETITIONS

Applicants hereby petition for reconsideration of a requirement of restriction for the present application. In an Office Action mailed June 30, 2003, the Examiner restricted claims 1-33 under 35 U.S.C. § 121 as follows:

- I. Claims 1-25 and 31-33, drawn to an apparatus, classified in class 29, subclass 740.
- II. Claims 26-30, drawn to a method, classified in class 29, subclass 832.

In addition to the above-described restriction, the Examiner asserted that Group I contains two patentably distinct species, referred to FIG. 1 and FIG. 4, and required the Applicants to elect one of the species. In a Response submitted August, 28, 2003, Applicants elected with traverse Group I and, within Group I, elected claims 1-11 that relate to the "species" of FIG. 4.

Restriction between Group I and Group II

In support of the restriction between Group I and Group II, the Examiner cited MPEP 806.05(e) which states that a process and an apparatus for its practice can be shown to be distinct inventions if either or both of the following can be shown: (1) that the process as claimed can be practiced by another materially different apparatus or by hand, or (2) that the apparatus as claimed can be used to practice another and materially different process. The Examiner then stated "the process as claimed can be practiced by hand."

In their response, Applicants traversed this restriction and submitted that the process cannot be practiced by hand without the use of Applicants' claimed apparatus. In particular, independent claim 26 of Group II recites numerous limitations of the claimed apparatus, thus preventing the recited method from being practiced by hand without the claimed apparatus. More particularly, the elements recited by independent process claim 26 require the operation or manipulation of the apparatus claimed in Group I. As one example, claim 26 recites "inserting a first tip of a first drive shaft . . . into a first receptacle assembly . . . so that a first helical groove on the first drive shaft aligns with a first pin located within the first receptacle assembly." Consequently, the claimed method of Group II cannot be practiced by hand without the claimed apparatus of Group I.

In the Office Action dated November 26, 2003, the Examiner dismissed the Applicants' arguments because "one can hold the first drive shaft and insert the first tip." Clearly, the Examiner is requiring a restriction of the apparatus claims of Group I and the process claims of Group II based on the premise that the claimed process can be performed by manipulating the claimed apparatus by hand. The Examiner is correct that the claimed process can be performed by manipulating the apparatus by hand. However, this does not form the basis for a proper restriction under MPEP 806.05(e).

When MPEP 806.05(e) is read as a whole, it is clear that the meaning of section (1) is that one-way distinctness is shown between a process and an apparatus for its practice when the process as claimed can be practiced by hand and without the use of the claimed apparatus. In other words, under MPEP 806.05(e), the Examiner may show that the process is distinct from the apparatus if the process may be practiced manually without requiring the use of the claimed apparatus. The Examiner has apparently misconstrued MPEP 806.05(e) to mean that the process is distinct from the apparatus if the process recites any step that may be practiced manually, even

if that step requires manipulating the apparatus itself. This is clearly not the meaning of MPEP 806.05(e) as this would not show one-way distinctness between the apparatus and the process.¹

Consequently, the restriction between Group I and Group II is improper and should be withdrawn.

Election of Species within Group I

The Examiner's assertion that Group I contains two patentably distinct species in reference to FIG. 1 and FIG. 4 is also erroneous. As indicated in Applicants' prior response, the Examiner misconstrued FIG. 1 and FIG. 4 and the claims readable thereon. Specifically, contrary to the Examiner's assertion, FIG. 1 and FIG. 4 do not show different species. Rather, FIG. 1 and FIG. 4 and the claims readable thereon are directed to a combination and a sub-combination. As described in Applicants' specification, FIG. 1 illustrates an example helical insertion and extraction device that assists in the insertion and extraction of printed circuit boards or other components from a device or subsystem such as a network router.² FIG. 4 illustrates the helical insertion and extraction device of FIG. 1 coupled with a printed circuit board prior to insertion into a system. Clearly FIG. 1 is directed to the device, i.e., a sub-combination, and FIG. 4 is directed to the device coupled to a printed circuit board, i.e., a combination. Consequently, in no manner do FIGS 1 and 4 represent different species.

In response to Applicants' traversal, the Examiner merely stated that "the Examiner gave species, not combination-subcombination restriction."³ This statement fails to address the fact that the species restriction required by the Examiner is erroneous. FIGS. 1 and 4 simply do not represent different species. Consequently, the Examiner's species-based restriction of claims directed to FIGS. 1 and FIG. 4 is improper.

For example, in order to restrict claims directed to the combination (FIG. 4) and the sub-combination (FIG. 1), the Examiner is required to show both two-way distinctness and reasons for insisting on the restriction, i.e., separate classification, status, or field of search.⁴ Because the Examiner has incorrectly viewed FIG. 1 and FIG. 4 and the claims readable thereon as species,

¹ "In applications claiming inventions in different statutory categories, only one-way distinctness is generally needed to support a restriction requirement." MPEP 806.05(e)

² Application, pg. 5, ll. 19-21.

³ Office Action dated November 26, 2003, pg. 2.

⁴ MPEP 806.05(c).

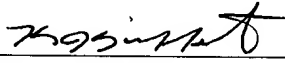
the Examiner has failed to meet these requirements. For example, the Examiner has failed to establish two-way distinctness, and the Applicants submit that the two-way distinctness does not exist. In this case, the claims readable on the combination clearly recite elements from the sub-combination. Moreover, in view of the claims and the recited elements of the sub-combination, it is clear that the Examiner will be required to perform co-extensive searches for the combination and the sub-combination. Accordingly, a restriction between the combination and sub-combination would be improper. The restriction between claims directed to the "species" of FIG. 1 and the "species" of FIG. 4 is improper and should be withdrawn.

Attached is a check in the amount of \$130.00 for the petition fee (37 C.F.R. § 1.17(h)). Please charge any additional fees or credit any overpayment to deposit account number 50-1778.

Respectfully submitted,

Date: January 22, 2004

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